

REMARKS

I. Status of Claims

Claims 1-88 are currently pending in this application. Applicants acknowledge and appreciate that the rejection of claims 20 and 26 under 35 U.S.C. § 112, ¶2 has been withdrawn.

II. Rejections under 35 U.S.C. § 103

A. U.S. Patent No. 5,984,975 to *Lagrange et al.* in view of U.S. Patent No. 5,976,195 to *de la Mettrie et al.*

The Examiner has maintained the rejection of claims 1-16, 20-52, and 54-88 under U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,984,975 to *Lagrange et al.* ("*Lagrange*") in view of U.S. Patent No. 5,976,195 to *de la Mettrie et al.* ("*de la Mettrie '195*") for the reasons set forth on pages 2-3 of the final Office Action.

Applicants respectfully traverse this rejection.

According to the Examiner, *Lagrange*, the primary reference, teaches hair dyeing compositions comprising oxidation bases, fatty alcohols as claimed, and thickening polymers of acrylic acid. *Final Office Action*, pages 2-3, *Office Action of December 19, 2002*, pages 3-4. *Lagrange* does not teach thickening polymers having the at least one fatty chain as claimed, but the Examiner purports to find these polymers in *de la Mettrie '195*, the secondary reference. *Id.* The Examiner summarily concludes:

It would have been obvious to one having ordinary skill in the art to be motivated to modify . . . *Lagrange* by replacing the polymeric thickener of acrylic acid with the thickening polymers of acrylic acid and methacrylic acid that has an allyl ether unit containing at least one fatty chain as taught by *de la Mettrie '195* with a reasonable expectation of success in obtaining more chromic (more luminous) shade.

Final Office Action, page 3. Applicants respectfully disagree, and believe that the Examiner's alleged evidence of a motivation to combine the teachings of the two references lack the requisite specificity to justify a §103(a) rejection. See *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (requiring "clear and particular" evidence of a motivation to combine references).

In making the rejection, the Examiner has not demonstrated that (1) the references, when considered as a whole, suggest the desirability of making the proposed combination; (2) the references do not teach away from the present invention; and (3) the references could, in fact, be modified with a reasonable expectation of success. Thus, the Examiner cannot and has not made a prima facie case of obviousness.

1. The Cited References Do Not Suggest the Desirability of the Claimed Invention

Neither *Lagrange* nor *de la Mettrie '195* suggest the desirability of replacing *Lagrange*'s optional thickener with *de la Mettrie 195*'s thickeners. The mere fact that *Lagrange* can optionally contain thickeners as set forth in column 10, lines 56-64, might have led one skilled in the art to try the thickeners disclosed in *de la Mettrie '195*. M.P.E.P. § 2145(X)(B). However, obvious to try is not the standard, and neither references contain any teaching that would have led one of skill in the art to select any other thickeners, let alone the thickener disclosed in *de la Mettrie*, to substitute in *Lagrange*'s composition.

The weakness in the Examiner's argument for the substitution of Lagrange's optional thickener is further highlighted by the fact that the *Lagrange* inventors did not seek to improve the intensity of the dye shade, as the Examiner suggests. Rather, as Applicants have argued on the record, the *Lagrange* inventors sought to discover novel dye precursors which would "produce a colour in the hair which [was] satisfactorily resistant to light, washing, inclement weather, perspiration and various treatments that [could] be applied to the hair." *Lagrange*, col. 1, lines 39-42. Thus, one of ordinary skill in the art would not have sought to replace a thickener, disclosed only as an optional component, to achieve a property, *i.e.*, more chromatic or luminous shade, that is not even disclosed or discussed in the primary reference.

2. *The Cited References Teach Away from the Present Invention*

Moreover, *de la Mettrie* '195 teaches away from the claimed invention because its preferred compositions do not include surfactants, such as the presently claimed fatty alcohols. The Examiner's response in the Final Office Action to this argument by Applicants is that *de la Mettrie* '195 suggests the use of a mixture of surfactants, such as non-ionic surfactants, in its dyeing compositions. To further buttress his argument, the Examiner adds that the fact that comparative Example 2 teaches inferior shade results when *de la Mettrie*'s claimed thickener is replaced with nonionic surfactants does not suggest that *de la Mettrie*'s compositions cannot contain surfactants. *Final Office Action*, page 3. The Examiner, however, has undervalued the significance of this reference's teaching away.

Indeed, one skilled in the art upon reading this reference would understand that *de la Mettrie* '195's compositions preferably do not contain surfactants, such as the fatty alcohols of *Lagrange*. *De la Mettrie* '195, in fact, indicates that it is advantageous to reduce the amount of surfactants in its compositions. *De la Mettrie* '195, col. 2, lines 22-24. Moreover, although *de la Mettrie* '195 mentions in passing that its compositions may contain surfactants, this disclosure is buried in a laundry list of optional ingredients that its compositions may contain. This hardly qualifies as evidence of motivation to include surfactants in a dyeing composition to achieve intense dye shades. *De la Mettrie* 195 may not negate the presence of surfactants in its compositions, but it clearly leads away from the use of such compounds. Indeed, the sole example in *de la Mettrie* '195 discloses that compositions containing surfactants result in a less chromatic shade - the very motivation that the Examiner now seeks to establish his improper prima facie case.

3. No Reasonable Expectation of Success

Finally, Applicants submit that no reasonable expectation of success would have existed for making the proposed combination. In particular, nothing in either reference suggests that the combination of at least one oxidation dye, at least one thickening polymer comprising at least one fatty chain, and at least one fatty alcohol within the scope of the invention would have at least an additive effect as opposed to a negative one. One skilled in the art would not know, without benefit of the present specification,

that the presently claimed combination would lead to a beneficial and improved dyeing composition. Indeed, the *de la Mettrie* '195 reference suggests otherwise.

For example, the *de la Mettrie* '195 inventors disclose that "[they] have observed that the ingredients of the traditional thickener, surfactant, and solvent type generally decrease the uptake of the dye on the fibers, which is reflected by a dull shade and also by the necessary use of more dye, solvent and/or surfactants to solubilize the type if it is desired to obtain an intense shade." *De la Mettrie* '195, col. 1., lines 41-46.

Accordingly, one skilled in the art would not reasonably expect the claimed combination of ingredients to result in compositions that resist running and provide more intense and radiant shades. *Present Specification*, page 2, lines 10-15.

In view of the above arguments, Applicants respectfully request withdrawal of this rejection.

B. *Lagrange* in view of *de la Mettrie* '195 and further in view of U.S. Patent No. 5,989,295 to *de la Mettrie*

The Examiner has rejected Claims 17-19 under 35 U.S.C. § 103(a) as unpatentable over *Lagrange* in view of *de la Mettrie* '195 and U.S. Patent No. 5,989,295 to *de la Mettrie* et al. ("*de la Mettrie* '295"). Applicants respectfully traverse this rejection, largely for the same reasons discussed above.

In the Office Action, the Examiner relies on the same arguments made in the rejection over *Lagrange* in view of *de la Mettrie* '195 to support the rejection. These arguments, however, are equally inappropriate here. Specifically, the Examiner has relied on *de la Mettrie* '295 to supply a teaching of the anionic thickeners recited in

claims 17-19 of the present specification. These thickeners are not disclosed in either the *Lagrange* or *de la Mettrie* references.

The Examiner's rejection is improper because he has provided no evidence of a motivation or suggestion to modify *Lagrange* in the first place by incorporating *de la Mettrie* 195's claimed thickeners. Therefore, the further modification to *Lagrange* using *de la Mettrie* 295's claimed thickeners is also improper. Accordingly, Applicants respectfully request that the Examiner withdraw this rejection for at least this reason.

Moreover, similar to the rejection above, the Examiner undervalues the significance of *de la Mettrie* 295's teaching away. *De la Mettrie* '295 also discloses that its compositions, without surfactants, provide a more luminous shades than compositions containing surfactants. Col. 11, lines 7-9. Additionally, *de la Mettrie* '295 discloses that prior art compositions containing traditional thickeners, surfactant and solvent type systems resulted in duller shades. Col. 1., 45-48. Thus, the arguments made above are equally applicable to this secondary rejection. More specifically, this secondary rejection is improper because *de la Mettrie* '295 teaches away from the presently claimed combination and does not suggest the desirability of the claimed combination. Accordingly, Applicants respectfully request that the Examiner withdraw this rejection as well.

C. *Lagrange* in view of *de la Mettrie* '195 and *de la Mettrie* '295 and further in view of U.S. Patent No. 5,538,517 to *Samain et al.*

The Examiner has rejected Claim 53 under 35 U.S.C. § 103(a) as unpatentable over *Lagrange* in view of *de la Mettrie* '195 and *de la Mettrie* '295 and further in view of

U.S. Patent No. 5,538,517 to *Samain et al.* ("*Samain*"). Applicants respectfully traverse this rejection.

The Examiner relies on the *Samain* reference for its teachings of dyeing compositions comprising enzymatic systems as oxidizing agents. *Final Office Action*, page 6. The Examiner alleges that *Lagrange, de la Mettrie '195*, and *de la Mettrie '295* teach hair dyeing compositions comprising oxidation bases and hydrogen peroxide as an oxidizing agent. *Id.* at page 4. *Samain*, according to the Examiner, teaches hair dyeing compositions comprising oxidation bases, hydrogen peroxide as an oxidizing agent or peroxidase as an enzymatic source of hydrogen peroxide. *Id.* The Examiner concludes "it would have been obvious to one having ordinary skill in the art to be motivated to modify the [cited references'] composition[s] by replacing hydrogen peroxide with the peroxidase as taught by *Samain* because the reference of *Samain* teaches the equivalence between hydrogen peroxide and peroxidase and further, the reference teaches that peroxidase enzyme[s] [are] used to generate hydrogen peroxide in the composition." *Id.* The Examiner's evidence of a motivation to make this alleged modification is simply not supported by the *Samain* reference.

First, the Examiner misreads the *Samain* reference by alleging that it teaches the equivalence between hydrogen peroxide and peroxidase enzymes. Contrary to the Examiner's allegation, *Samain* does not teach that peroxidase enzymes can be used to generate hydrogen peroxide. Rather, it teaches that these ingredients are two separate components in its composition, i.e., its compositions comprise "at least one peroxidase enzyme" and "at least hydrogen peroxide or an enzymatic source of hydrogen

peroxide." See col. 2, lines 19-24. In fact, the peroxidase enzymes do not generate hydrogen peroxide, it only reacts with it. Col. 2, lines 39-61. Therefore, these two components are not equivalent, as alleged by the Examiner.

Second, *Samain* would have provided no motivation to make the claimed invention. Even when viewed in conjunction with the other cited references, it does not suggest the use of peroxidase enzymes in a composition comprising the presently claimed oxidation bases, thickening polymers, and fatty alcohols. The only reference in *Samain* to the use of thickening polymers and fatty alcohols in its compositions is a passing statement that its compositions may comprise additional adjuvants. Accordingly, Applicants request that the Examiner withdraw this improper rejection as well.

III. Conclusion

In light of the foregoing remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims. Please grant any extensions of time required to enter this Response, and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 8, 2004

By: Mareesa Frederick
Mareesa A. Frederick
Reg. No. 55,190